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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/671,026	09/24/2003	Bruce Karsh	50269-0562	7849
7590	05/09/2006		EXAMINER	
HICKMAN PALERMO TRUONG & BECKER, LLP 1600 WILLOW STREET SAN JOSE, CA 95125			FRISBY, KESHA	
			ART UNIT	PAPER NUMBER
			3715	

DATE MAILED: 05/09/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

<b>Office Action Summary</b>	<b>Application No.</b>	<b>Applicant(s)</b>	
	10/671,026	KARSH ET AL.	
	<b>Examiner</b>	<b>Art Unit</b>	
	Kesha Frisby	3715	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

#### Status

1) Responsive to communication(s) filed on 24 September 2003.  
 2a) This action is FINAL.                    2b) This action is non-final.  
 3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

#### Disposition of Claims

4) Claim(s) 1-14 is/are pending in the application.  
 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.  
 5) Claim(s) \_\_\_\_\_ is/are allowed.  
 6) Claim(s) 1-14 is/are rejected.  
 7) Claim(s) \_\_\_\_\_ is/are objected to.  
 8) Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

#### Application Papers

9) The specification is objected to by the Examiner.  
 10) The drawing(s) filed on 9/24/2003 is/are: a) accepted or b) objected to by the Examiner.  
     Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
     Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).  
 11) The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

#### Priority under 35 U.S.C. § 119

12) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).  
 a) All    b) Some \* c) None of:  
     1. Certified copies of the priority documents have been received.  
     2. Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.  
     3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

#### Attachment(s)

1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)	4) <input type="checkbox"/> Interview Summary (PTO-413)
2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)	Paper No(s)/Mail Date. _____
3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) Paper No(s)/Mail Date _____	5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)
	6) <input type="checkbox"/> Other: _____

## DETAILED ACTION

### ***Claim Rejections - 35 USC § 101***

1. 35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

Claims 4-6 & 11-13 are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter. Claim 4 appears to be an abstract idea rather than a practical application of the idea. Claim 4 does not result in a physical transformation nor does it appear to provide a use, concrete and tangible result. Therefore, claim 1 appears non-statutory. None of these dependent claims 4-6 & 11-13 correct this problem therefore they are also rejected. Please see MPEP 2106 for guidance.

### ***Claim Rejections - 35 USC § 102***

2. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

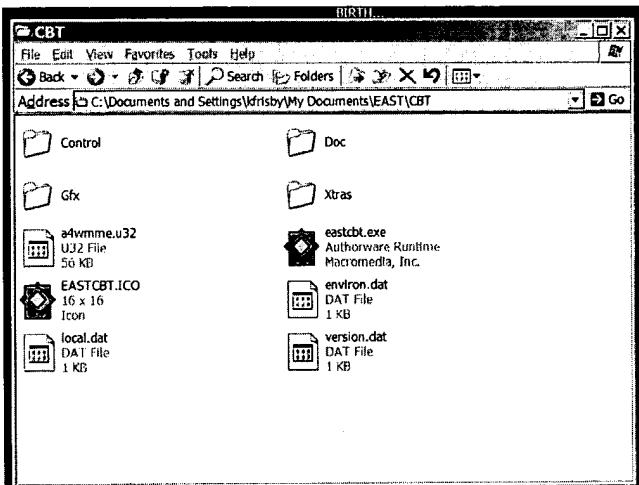
A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

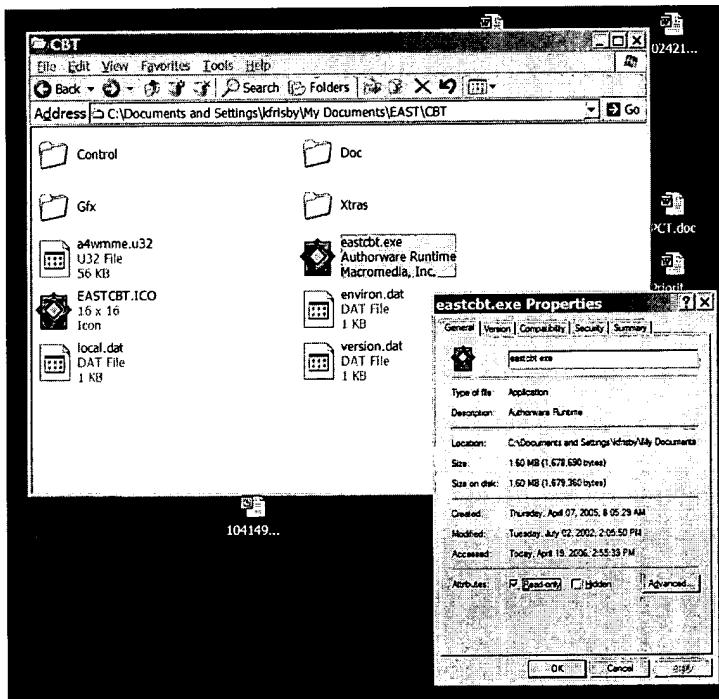
3. **Claims 1-4, 7-11 & 14 are rejected under 35 U.S.C. 102(b) as being anticipated by East (SIRA: Search & Information Resources Administration at the United States Patent & Trademark Office). When rejecting these claims examiner viewed East as a whole, even though the literature submitted has different prior art dates.**

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However, the dates of the prior art documents were before the effective filling date (9/24/2003) of the applicant's application.



After right clicking on eastcbt.exe



The above screen shots have been provided to prove the date of the submitted information (PTO East Training documents dated (July 2, 2002)).

Here is an additional reference used for the rejection below:

The U.S. Patents Text Search Quick Reference Guide for East (1.1) (November 2000).

Referring to claim 1, East discloses receiving data that specifies a first form of a component word (input into BRS form, with the use of truncation, for example: fish\$); locating, within said compound word (for example, the compound word is fisherman), a second form of said component word (in this case, fisher) that differs from said first form of said component word (Once the browse button is pressed the words that are constructed from the use of the truncation fish\$ is highlighted); and displaying said compound word with said second form of said component word visibly distinguished from the remainder of said compound word (the use of the Find function, such as, typing in fisher).

Referring to claim 2, East discloses wherein said second form of said compound word is a superlative form of said first form of said compound word (the examiner views this limitation as based on what the user is searching/trying to find will determine whether or not the compound word is in superlative form).

Referring to claim 3, East discloses wherein said second form (man) of said compound word (fisherman) does not contain said first form (fish) of said compound word (fisherman).

Referring to claim 4, East discloses (still working with the example above: fisherman) determining a first stem word (fish) associated with said compound word (fisherman); determining a second stem word (man) associated with said compound word (fisherman); based on a comparison between letters in said first stem word and said

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compound word, determining a first starting position (starting with the letter "f"); based on a comparison between letters in said second stem word and said compound word, determining a second starting position (starting with the letter "m"); determining, based on said first starting position and said second starting position associated with said first stem word (starting with the letter "m"); and determining, based on said first starting position and said second starting position, an ending position associated with said first stem word (ending with the letter "h").

Referring to claim 7, East discloses further comprising: displaying said compound word with letters at (beginning with the letter "f") and between (letters "ish") said starting position associated with said first stem word (starting with the letter "f") and said ending position (ending with the letter "h") associated with said first stem word ("fish") visibly distinguished from the remainder of said compound word ("fisherman") (the word "fish" is lighted on the computer screen when using the Find function and typing in "fish").

Referring to claim 8, East discloses a computer-readable medium carrying one or more sequences of instructions which, when executed by one or more processors, causes the one or more processors to perform the method of claim 1 (see rejected claim 1).

Referring to claims 9, East discloses a computer-readable medium carrying one or more sequences of instructions which, when executed by one or more processors, causes the one or more processors to perform the method of claim 2 (see rejected claim 2).

Referring to claim 11, East discloses a computer-readable medium carrying one or more sequences of instructions which, when executed by one or more processors,

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causes the one or more processors to perform the method of claim 3 (see rejected claim 3).

Referring to claim 11, East discloses a computer-readable medium carrying one or more sequences of instructions which, when executed by one or more processors, causes the one or more processors to perform the method of claim 4 (see rejected claim 4).

Referring to claim 14, East discloses a computer-readable medium carrying one or more sequences of instructions which, when executed by one or more processors, causes the one or more processors to perform the method of claim 7 (see rejected claim 7).

### ***Claim Rejections - 35 USC § 103***

4. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

5. Claims 5, 6, 12 & 13 are rejected under 35 U.S.C. 103(a) as being unpatentable over **East (SIRA: Search & Information Resources Administration at the United States Patent & Trademark Office) in view of Hull et al. (U.S. Publication Number 2003/0187886.**

Referring to claim 5, East discloses the method of Claim 4. *East does not disclose wherein determining said first starting position comprises: determining, for a first sequence of letters in said compound word, a first score based on how many letters in*

*said first sequence match letters in said first stem word; determining, for a second sequence of letters in said compound word, a second score based on how many letters in said second sequence match letters in said first stem word; and determining said first starting position based on said first score and said second score. East also does not disclose wherein determining said second starting position comprises: determining, for a third sequence of letters in said compound word, a third score based on how many letters in said third sequence match letters in said second stem word; determining, for a fourth sequence of letters in said compound word, a fourth score based on how many letters in said fourth sequence match letters in said second stem word; and determining said second starting position based on said third score and said fourth.* However, Hull et al. teaches determining, for a first sequence of letters in said compound word, a first score based on how many letters in said first sequence match letters in said first stem word; determining, for a second sequence of letters in said compound word, a second score based on how many letters in said second sequence match letters in said first stem word; and determining said first starting position based on said first score and said second score (paragraphs 0030 & 0031). Hull et al. also teaches wherein determining said second starting position comprises: determining, for a third sequence of letters in said compound word, a third score based on how many letters in said third sequence match letters in said second stem word; determining, for a fourth sequence of letters in said compound word, a fourth score based on how many letters in said fourth sequence match letters in said second stem word; and determining said second starting position based on said third score and said fourth score (paragraphs 0030 & 0031). It would

have been obvious to one of ordinary skill in the art at the time the invention was made to include determining first, second, third and fourth sequences of letters, as well as, determining the first and second starting positions, as disclosed by Hull et al., incorporated into East in order to know where to start highlighting.

Referring to claim 12, East, as modified by Hull et al., teaches computer-readable medium carrying one or more sequences of instructions which, when executed by one or more processors, causes the one or more processors to perform the method of claim 5 (see rejected claim 5).

Referring to claim 13, East, as modified by Hull et al., teaches a computer-readable medium carrying one or more sequences of instructions which, when executed by one or more processors, causes the one or more processors to perform the method of claim 6 (see rejected claim 6).

***Citation of Pertinent Prior Art***

6. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

McGreevy (U.S. Publication Number 2003/0004914) teaches a system, method and apparatus for conducting a phrase search.

McGreevy (U.S. Publication Number 2002/0188587) teaches a system, method and apparatus for generating phrases from a database.

Hull et al. (U.S. Patent Number 6,671,684) teaches the use of scoring and highlighting within a document.

***Conclusion***

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Kesha Frisby whose telephone number is 571-272-8774. The examiner can normally be reached on Mon. - Wed. 7-3pm, Thu. 6:30-4pm & Fri. 7-4pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Robert Olszewski can be reached on 571-272-6678. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

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 5/11/06  
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